

Application No. 10/062,798

Written Reply dated January 16, 2007

Responsive to Information Requirement mailed November 14, 2006

REMARKS

First, the Examiner has requested that Applicants "provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of the energy auction system described of the specifications."

In response to the first interrogatory, the undersigned has been informed that Applicants have neither authored nor co-authored any *conventional* publications describing the subject-matter of the energy auction system described in the specifications, e.g., journal or magazine articles, books, etc. However, Applicants note the following in regard to other writings that might be considered "publications" under a broad reading of the Examiner's first interrogatory:

Applicants assisted with the preparation (authoring) of the Application and those other patent applications sharing the priority chain of the Application. Such patent applications and two patents issuing therefrom to date have been published (or made publicly available) by the USPTO. Applicants also participated in the preparation of PCT Application No. PCT/US98/02910 published by WIPO on September 11, 1998, and PCT Application No. PCT/US01/08639 published by WIPO on October 11, 2001.

The public utility commissions ("PUCs") in the states of New Jersey, Ohio and Illinois have each conducted public proceedings in the course of authorizing electric power auctions in their respective states. Applicants have communicated by letter with each of these PUCs to make them aware of Applicants' issued patents and pending patent applications (including the present Application) regarding certain energy auction systems. These letters may have become part of the public record of such PUC proceedings. After reviewing these

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letters (as well as certain letters sent by Applicants to third parties, copies of which were also furnished by Applicants to such PUCs in the course of their public proceedings), Applicants enclose the following:

- (A) Letter to Frances L. Smith, Secretary of the New Jersey Board of Public Utilities dated November 2, 2001 (three pages).
- (B) Letter to Jeanne M. Fox, President of the New Jersey Board of Public Utilities, dated July 12, 2002, including as an attachment thereto a letter to Irah H. Donner of Hale and Dorr, LLP, counsel to certain electric utility companies in New Jersey, dated April 30, 2002 (eight pages including said attachment).
- (C) Letter to New Jersey Board of Public Utilities dated January 30, 2003 (four pages).
- (D) Letter to New Jersey Board of Public Utilities dated October 17, 2003 (two pages).
- (E) Letter to New Jersey Board of Public Utilities dated January 26, 2004 (three pages).
- (F) Letter to the Public Utilities Commission of Ohio dated November 19, 2004 (three pages).
- (G) Letter to The Illinois Commerce Commission dated August 18, 2006 (three pages).

The Examiner's second and third interrogatories in the Information Requirement respectively request the Applicants to "provide the names of any products or services that have incorporated the claimed subject matter" and "provide the names of any products or services that have incorporated the claimed invention."

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Applicants have not introduced into the marketplace any product or service that incorporates the claimed subject matter and/or claimed invention of the present Application. Regarding such products or services introduced by third parties, Applicants believe that certain electric power auctions conducted by electric utility companies in the states of New Jersey, Ohio and Illinois, and authorized by the respective PUCs in such states (as referenced above), may incorporate the claimed subject matter and/or the claimed invention of the present Application. For the Examiner's convenience, more information about each of these electric power auctions can be found at the following website addresses: (i) for the New Jersey Basic Generation Service Auction, see <http://www.bgs-auction.com> and <http://www.bpu.state.nj.us/home/bgs.shtml>; (ii) for the Ohio Competitive Bid Process in late 2004, see <http://dis.puc.state.oh.us/CaseRecord.aspx> (Note: In "case lookup #" box in upper right of webpage, enter the case number "04-1371-EL-ATA" and click "search"); and (iii) for the Illinois Auction in September 2006, see <http://www.illinois-auction.com> and <http://www.icc.illinois.gov/e-Docket/reports/browse/default.asp> (then enter one or more of the following four docket numbers and select "Go": 05-0159, 05-0160, 05-0161 and 05-0162). Applicants also refer the Examiner to the Petition to Make Special filed in July 2003 with respect to the present Application and which discusses in brief the New Jersey Basic Generation Service Auction.

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Applicants have informed the undersigned that they are aware of other governmental and private entities who have authorized, sponsored or conducted energy-related auctions or competitive bidding programs, but Applicants either believe such auctions or bidding programs do not incorporate the claimed subject matter or the claimed invention as disclosed in the present Application or do not know sufficient specific details about such auctions or bidding programs to make a definitive determination to that effect. For example, Applicants are aware of an energy auction service offered by World Energy Exchange, a private company operating a website at www.worldenergy.com/wee.html. Based on the limited information available to the public on the website (as opposed to the specific details made available to registered, pre-screened buyers and sellers), Applicants have not yet been able to evaluate whether World Energy Exchange's auction service "incorporates the claimed subject matter" or "the claimed invention" of the present Application. In this regard, Applicants respectfully submit that Applicants are not required to "derive or independently discover a fact ... in response to a requirement for information."

See M.P.E.P. § 704.11.

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CONCLUSION

Should there remain any questions or other matters whose resolution could be advanced by a telephone call, the Examiner is invited to contact the undersigned attorney at the number below. Although the undersigned believes that no extension of time request and fee is due in connection with this Response, to any extent such petition would be due to consider this Response, the undersigned respectfully requests that this Response be considered as including a petition therefor and the Examiner charge the fee to Deposit Account 503571. The Examiner is authorized to charge any deficiency and/or credit any overpayment to Deposit Account 503571.

Respectfully submitted,

McCARTER & ENGLISH, LLP

A handwritten signature in black ink, appearing to read 'M. Friscia', with a stylized, cursive script.

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